

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DARRYL C. BODINE and DOUGLAS G. VERNAU

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Appeal No. 98-1449  
Application No. 08/297,122<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge,  
FRANKFORT and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 and 7, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed August 29, 1994.

BACKGROUND

The appellants' invention relates to a ceiling system. An understanding of the invention can be derived from a reading of exemplary claim 6, which appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Shaub	4,769,965	Sept. 13,
1988		

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shaub.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 13, mailed June 17, 1997) and the supplemental examiner's answer (Paper No. 15, mailed September 17, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 12, filed March 24, 1997)

and reply brief (Paper No. 14, filed August 14, 1997) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claims 6 and 7. Accordingly, we will not sustain the examiner's rejection of claims 6 and 7 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references

before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the examiner's rejection of claims 6 and 7. The examiner found (answer, p. 3) that Shaub teaches all the claimed subject matter except that Shaub's ceiling board 30 does not include "depressed areas in the support edge means at the corners of the board." The examiner then stated (answer, pp. 3-4) that

[i]t is well known in any facet of construction that if there are two or more elements which interfere with each other or there is an interference fit that some form of relieving, notching or removal of a portion of one of the elements would be performed. This is a rather typical procedure and is "obvious" in the true sense of the word. The concept has universal application and is just as relevant to an apparent unsightly suspended ceiling system as to a basic framing of a building. It is further well known to customize a component to fit into an existing system. Therefore, if the raised portions of the ceiling grid system cause the ceiling board to lie unevenly, it would have been obvious to one with ordinary skill in the art to modify the board of Shaub by removing the offending portions thereof, i.e. creating depressions in the corners, to create a tolerance for the raised portions of the ceiling grid system so that the support edge means of the board may lie flat against the support means of the ceiling grid system around the entire perimeter, thus presenting a level finished construction by modifying the ceiling board with a method old and well known in the art.

The appellants seasonably challenged (see Paper No. 5, filed February 7, 1996, and the brief) the above-noted assertions of well known prior art. Accordingly, the assertions have not been established as admitted prior art. The Manual of Patent Examining Procedure (MPEP) § 706.02(a) states that "if the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." In this case, the examiner did not cite a reference in support of the assertions of "well known" prior art.

Since the above-noted unsupported assertions cannot be used as prior art, it is clear that the examiner's rejection of claims 6 and 7 fails to establish a prima facie case of obviousness. That is, the examiner has failed to present evidence that would appear to be sufficient for one of ordinary skill in the art to make the proposed modification. Accordingly, the decision of the examiner to reject claims 6 and 7 under 35 U.S.C. § 103 is reversed.<sup>2</sup>

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<sup>2</sup> The examiner should consider whether the prior art of record (e.g., Likozar, Blacklin, Shaub, Meredith,

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Fotheringham, etc.), or other prior art not presently of record, taken with the appellants' evidence of nonobviousness (i.e., the affidavit of Stephen M. Newcomer (attached to Paper No. 5)) establishes obviousness of the claimed subject matter under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject  
claims 6 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	



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APPEAL NO. 98-1449 - JUDGE NASE  
APPLICATION NO. 08/297,122

APJ NASE

SAPJ McCANDLISH

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 25 Jan 99

**FINAL TYPED:**